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REMARKS

In the Office Action of May 5, 2004, the Examiner has provisionally rejected claims 1-18 under 35 USC 101, because the claimed invention is not a patentable invention. Claims 1-18 are rejected under 35 USC 112, first paragraph, as containing subject matter which was not described in the specification. Claims 1-18 are rejected under 35 USC 102(e) as being anticipated by Enokido et al, or alternatively by Mitchell.

The Office Action of May 5, 2004, has been carefully considered and by this amendment, entry of which is respectfully requested, claims 1-18 remain in the application; claims 1, 4-7, 10, 14 and 16 have been amended. The amendments do not add new matter.

In the Office Action, the Examiner has stated that independent claims 1 and 10 and dependent claims 2-9 and 11-18 do not claim a patentable invention. Applicant respectfully traverses the 101 rejection because although the present invention automates a comparison process, the invention is not mere automation, the invention is a "real-time method and system for comparing current design features to required and quantifiable limits for design", as stated in the originally filed specification on page 2. Automation of the existing manual process does not negate the fact that patentable steps and elements are required to achieve the invention.

Claims 1-18 are clearly directed to statutory subject matter, because independent claims 1 and 10 contain "physical process steps". In re Abele, 214 USPQ 682 (CCPA 1982) at 686. See also, Arrhythmia Research Technology, Inc. v. Corazonix Corp., 958 F.2d 1053, 1058, 22 USPQ2d

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1033, 1037 (Fed. Cir. 1992). In applying the Freeman-Walter-Abele test in Arrhythmia Research, the majority found that steps such as "converting", "**applying**", "determining", and "**comparing**" are physical process steps, not merely data gathering steps, making claims including that language statutory. Both claims 1 and 10 require the steps or elements of "**applying** the analysis algorithm to perform calculations to generate an analyses output"; and "**comparing** the analyses output to the limits to generate a design output". It is therefore respectfully submitted that independent claims 1 and 10 are directed to statutory subject matter, since claims 1 and 10 contain physical process steps as defined by the Federal Circuit.

Turning now to the rejection of claims 1-18 under 35 USC 112, first paragraph, it is respectfully submitted that the claims, as now amended, comply with 35 USC 112. Specifically, independent claims 1 and 10, as well as dependent claims 4-7, 14 and 16 have been amended to more particularly point out and distinctly claim subject matter adequately described in the specification. A claim, in order to pass muster under 35 USC §112, second paragraph, need only be clear to one skilled in the art, when read in light of the specification, so as to permit one skilled in the art to define the metes and bounds of the invention. In re Goffe, 188 USPQ 131, 135 (CCPA 1975). The manner of comparing and applying are now encompassed in the claims in language fully supported by the specification. With the amendments represented herein, it is respectfully submitted that one skilled in the art could define the metes and bounds of the invention.

Applicant respectfully traverses the rejection

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of claims 1-18 under 35 USC §102(e), for the reason that the cited art does not teach, anticipate, or render obvious the invention of Applicant, as now claimed.

The test for determining if a cited document anticipates a claim, for purposes of a rejection under 35 USC §102, is whether the cited document discloses all of the elements of the claimed combination, or the mechanical equivalents, functioning in substantially the same way to produce substantially the same results. As noted by the Court of Appeals of the Federal Circuit in Lindemann Maschinenfabrick GmbH v. American Hoist and Derrick, 221 USPQ 481, 485 (1984), in evaluating the sufficiency of an anticipation rejection under 35 USC §102:

"Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim."

In considering the Enokido and Mitchell documents cited by the Examiner, it is respectfully submitted that these documents do not anticipate the subject invention. The Enokido document is directed to a test specification which is prepared to specify indexes and/or instructions for testing an application program - where the application program is used in a production process stage of a business software system. Test information items are used to generate the test specification. The Enokido patent does not in any way claim a stage of the design process. Enokido specifically states that the programming of an application program occurs during the production process, whereas the design process is when a computer-aided software engineering tool is utilized. The Enokido reference does not teach or suggest knowledge and

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tools for solving design process problems. It is respectfully submitted, therefore, that independent claims 1 and 10 of the subject application are not anticipated by the cited patent.

The Mitchell reference discloses and claims monitoring of inlet water usage. Mitchell simply does not disclose each and every element of the claimed invention, arranged as in the claim. Mitchell is proposing using calculations and information to determine if excessive usage or leakage of water is occurring, but does not in any way disclose or claim elements or steps capable of being applied to comparison of current design features to required and quantifiable limits for design.

In light of the amendments and remarks herein, it is respectfully suggested that all of the claims of the subject application disclose patentable subject matter, which subject matter is not anticipated or obviated by the cited documents, taken singularly or in combination, since the cited documents fail to disclose the elements of the claimed invention, arranged as in the claim, with the purpose defined in the subject application.

Claims 2-9 and 11-18 depend from independent claims 1 or 10 to contain all of the limitations found therein. By this dependency, it is submitted that these claims are not anticipated, taught, or rendered obvious by the cited document. Additionally, these claims add further limitations which distinguish them patentably from the cited documents. Accordingly, withdrawal of the rejection of all of the claims of the application is respectfully requested.


Applicants' attorney has reviewed the additional art cited by but not relied upon by the Examiner.

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That document does not teach, anticipate, or render obvious, when taken singularly or in combination with the relied upon art, the invention of applicants disclosed in the subject application.

In view of the foregoing remarks, the undersigned attorney respectfully submits that all of the claims of the application are clearly allowable. Therefore, Applicant's attorney respectfully requests that the Examiner's objections and rejections be withdrawn and that a formal Notice of Allowance be issued thereon.

Respectfully submitted,

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